

**REMARKS**

Claims 1-8, 10-33, 38-60, and 62-71 are pending in this application.

Applicants have amended claims 1, 12, 18, 22, 26, 30, 38, 47, 52, 55, 57, 62, 64, 66-69, and 71, and have canceled claims 34-37 and 61 (claim 9 was previously canceled). These changes do not introduce any new matter.

**Rejection Under 35 U.S.C. § 101**

In light of the cancellation of claims 34-37 and 61, the rejection of these claims under 35 U.S.C. § 101 as being directed toward nonstatutory subject matter is moot.

**Rejection Under 35 U.S.C. § 102**

Applicants respectfully request reconsideration of the rejection of claims 1, 2, 5-8, 10, 11, 18-21, 26-29, 52-54, 57-65, 67, and 69-71 under 35 U.S.C. § 102(b) as being anticipated by *Shiota et al.* (U.S. Patent No. 6,011,547) (as noted above, claim 61 has been canceled herein). As will be explained in more detail below, the *Shiota et al.* reference does not disclose each and every feature specified in independent claims 1, 18, 26, 52, 57, 62, 64, 67, 69, and 71, as amended herein.

The *Shiota et al.* reference discloses that an image reproducing apparatus adds an image processing condition to image data. *Shiota et al.*, however, carry out a computation in accordance with a predetermined algorithm to obtain an optimal image processing condition, and adds the obtained condition to the target image data (see column 5, line 54, to column 6, line 9).

The *Shiota et al.* reference fails to state, and neither discloses nor suggests, at least one feature of the presently claimed subject matter, namely, the image process control information being preliminarily determined according to a combination of an image generating characteristic of an image data generating apparatus and reproduction characteristics of an output apparatus.

As the claimed configuration preliminarily determines the image process control information according to a combination of the image generating characteristic of the image data generating apparatus and reproduction characteristics of the output apparatus, *the image reproducing apparatus or the image data generating apparatus does not have to carry out a computation in accordance with a predetermined algorithm*, and the image data generating apparatus is capable of adding the image process control information to image data when generating the image data.

The *Shiota et al.* reference states “it becomes unnecessary to carry out the same processing again” (column 5, lines 59-60). As such, *Shiota et al.*’s invention is configured to add an image processing condition to image data, so as to avoid the inefficiency of repeating the same routine, namely, carrying out a computation in accordance with a predetermined algorithm to obtain an optimal image processing condition. Conversely, *Shiota et al.*’s configuration requires at least one round of computation in accordance with a predetermined algorithm to obtain an optimal image processing condition.

On the other hand, the claimed subject matter does not need a single routine of carrying out a computation in accordance with a predetermined algorithm to obtain an optimal image processing condition as disclosed in the *Shiota et al.* reference. In the presently claimed subject matter, the image process control information is preliminarily determined according to a combination of the image generating characteristic of the image data generating apparatus and the reproduction characteristics of the output apparatus, and the image processing apparatus only has to carry out image processing based on the image process control information.

Applicants respectfully traverse the Examiner’s contention that the *Shiota et al.* reference discloses the claimed feature of an image data generating apparatus directly or indirectly associating image process control information with image data. In the *Shiota et al.*

reference, the image data generating apparatus is incapable of setting an image processing condition because the image reproducing apparatus sets an optimal image processing condition. Thus, the *Shiota et al.* reference fails to disclose the concept of directly associating image process control information with image data.

*Shiota et al.*'s image reproducing apparatus sets an "optimal" image processing condition based on recording information, and this recording information is just the condition at the time of image shooting, as defined in the *Shiota et al.* reference (see column 4, line 5, to column 5, line 35, and particularly column 5, lines 22-23). This demonstrates that the *Shiota et al.* reference fails to disclose or suggest the concept of indirectly associating image process control information with image data.

The claimed subject matter enables an image data generating apparatus to control an image processing apparatus (e.g., a printer) so as to easily obtain a high quality image without the need to perform the task of setting an image processing condition with the image processing apparatus. In contrast, in *Shiota et al.*'s configuration, the image reproducing apparatus sets an optimal image processing condition, and the image data generating apparatus is incapable of controlling the image reproducing apparatus. Instead, the image reproducing apparatus, by itself, independently carries out image processing based on the recording information (Exif printing).

In view of the foregoing, the claimed subject matter is distinguishable from the configuration shown by *Shiota et al.* Moreover, it is clear that the claimed subject matter and *Shiota et al.* are intended to solve different problems.

Accordingly, for at least the foregoing reasons, independent claims 1, 18, 26, 52, 57, 62, 64, 67, 69, and 71, as amended herein, are patentable under 35 U.S.C. § 102(b) over *Shiota et al.* The claims depending from the above-listed independent claims are likewise

patentable under 35 U.S.C. § 102(b) over *Shiota et al.* for at least the same reasons set forth regarding the applicable independent claim.

Rejections Under 35 U.S.C. § 103

Applicants respectfully request reconsideration of the rejection of claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* in view of *Liu et al.* (U.S. Patent No. US 6,523,046 B2). The *Liu et al.* reference does not cure the above-discussed deficiencies of the *Shiota et al.* reference relative to claim 1, as amended herein. Accordingly, claims 3 and 4 are patentable under 35 U.S.C. § 103(a) over the combination of *Shiota et al.* in view of *Liu et al.* for at least the same reasons set forth above regarding claim 1.

Applicants respectfully request reconsideration of the rejection of claims 12-17, 22-25, 30-36, 47-51, 55, and 56 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* in view of *Telle* (U.S. Patent No. 5,105,266) (as noted above, claims 34-36 have been canceled herein). The *Telle* reference, which is cited to show the converting of colors from one color space to an absolute color space, does not cure the above-discussed deficiencies of the *Shiota et al.* reference relative to the presently claimed subject matter. Thus, the combination of *Shiota et al.* in view of *Telle* would not have suggested to one having ordinary skill in the art the subject matter defined in claims 12-17, 22-25, 30-33, 47-51, 55, and 56.

Accordingly, claims 12-17, 22-25, 30-33, 47-51, 55, and 56 are patentable under 35 U.S.C. § 103(a) over *Shiota et al.* in view of *Telle*.

In light of the cancellation of claim 37, the rejection of claim 37 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* in view of *Telle* and *Liu* is moot.

Applicants respectfully request reconsideration of the rejection of claims 38-42 and 44-46 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* in view of *Kondo* (U.S. Patent No. US 6,281,992 B1). Neither the *Shiota et al.* reference nor the *Kondo* reference discloses or suggests the use of image process control information that is

*preliminarily* determined according to a combination of an image generating characteristic of the image data generating apparatus and reproduction characteristics of the output apparatus, as specified in the presently claimed subject matter. Accordingly, independent claim 38 and claims 39-42 and 44-46 that ultimately depend therefrom are patentable under 35 U.S.C. § 103(a) over *Shiota et al.* in view of *Kondo*.

Applicants respectfully request reconsideration of the rejection of claim 43 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* in view of *Kondo* and *Liu et al.* Claim 43 ultimately depends from independent claim 38. None of the *Shiota et al.*, *Kondo*, and *Liu et al.* references discloses or suggests the use of image process control information that is *preliminarily* determined according to a combination of an image generating characteristic of the image data generating apparatus and reproduction characteristics of the output apparatus, as specified in the presently claimed subject matter. Accordingly, claim 43 is patentable under 35 U.S.C. § 103(a) over the combination of *Shiota et al.* in view of *Kondo* and *Liu et al.*

Applicants respectfully request reconsideration of the rejection of claims 66 and 68 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* in view of *Telle* and *Kondo*. Neither the *Telle* reference nor the *Kondo* reference cures the above-discussed deficiencies of the *Shiota et al.* reference relative to the presently claimed subject matter. Accordingly, for at least the foregoing reasons, claims 66 and 68 are patentable under 35 U.S.C. § 103(a) over the combination of *Shiota et al.* in view of *Telle* and *Kondo*.

#### Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 1-8, 10-33, 38-60, and 62-71, as amended herein, and submit that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution

**Application No. 09/941,711**  
**Amendment dated August 21, 2007**  
**Response to Office Action dated May 21, 2007**

of this application, the Examiner may reach the undersigned at (408) 749-6902. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP005).

Respectfully submitted,  
MARTINE PENILLA & GENCARELLA, L.L.P.

A handwritten signature in black ink, appearing to read 'Peter B. Martine', with a long horizontal flourish extending to the right.

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